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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,494	04/12/2004	Gary Bridger	391442006300	6459
25225	7590	11/20/2006		
MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
			EXAMINER DAVIS, ZINNA NORTINGTON	
			ART UNIT 1625	PAPER NUMBER

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,494

Applicant(s)

BRIDGER ET AL.

Examiner

Zinna Northington Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 5,9-14,23-41,44-52 and 54-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,8,15,16,18,20-22,42,43 and 53 is/are rejected.
- 7) ☒ Claim(s) 3,6,17,and19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on April 12, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/04:1/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-56 are pending.
2. In the response filed August 24, 2006, Applicants have elected Group I, Claims 1-22, 42, 43, and 53 without traverse. The compound of Example 19 is the preferred species.
3. Base upon the preferred species, *claims 1-4, 6-8, 11, 12, 15-22, 42, 43, and 53* are drawn to the elected species.
4. Claims 5, 9-14, 23-41, 44-52, and 54-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.
5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).
6. Claims 1-4, 6-8, 11, 12, 15-22, 42, 43, and 53 are Markush claims which are generic to the elected invention. These Markush claims lack unity of invention. Accordingly, the Markush type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. See MPEP 803.02.
7. Claims 1-4, 6-8, 11, 12, 15-22, 42, 43, and 53 are objected on the grounds that the claims are drawn to an improper Markush group. In re Harnisch, 206 USPQ 300,

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states that a unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. In the instant case, the claimed subject matter does not share a substantial structural feature disclosed as being essential to that utility.

The requirement for a proper Markush claim is that it includes only substances that in their physical, chemical and physiological characteristics are functionally equivalent. The members of the instant Markush groups possess widely different, physical and chemical properties. The compounds are not considered functionally equivalent and are so diverse that they demonstrate dissimilar and unrelated properties. The mere fact that there is structural similarity in pharmaceutical agents is not in itself reason to render all the embodiments functionally equivalent.

The improper Markush groups are A, R¹, R², R³, X, and Y.

8. The examined subject matter is as follows:

A compound of formula I where A does not form an additional ring; R¹ and R² do not form an additional ring; X is (CR³₂)_o-(CR³=CR³)_p-(CR³₂)_q-NR⁵₂. The radicals not defined herein are defined according to claim 1. Amending the claims to the examined subject matter would overcome the improper Markush rejection.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claims 1, 2, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- A. At claim 1, it is suggested that the phrase " and the salts, prodrugs and stereoisomeric forms" should be amended to read as – or a salt, prodrug, and stereoisomeric form--.
- B. At claim 1, what radicals are intended by the phrase " a non-interfering substituent? Clarification is appreciated.
- C. At claim 2, what are the substituents to be further substituted? Clarification is appreciated.
- D. At claim 22, the compounds refer to examples, which is improper.
11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

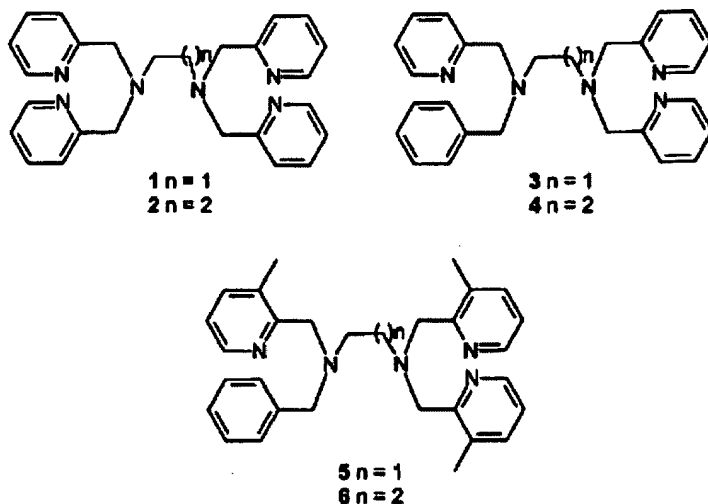
A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 4, 7, 8, 15, 16, 18, 20, 22, 42, 43, and 53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brinksma et al (Reference U, cited by Examiner).

The instantly claimed compounds are disclosed. At page 76, 1st column, see compounds 1, 2, 3, 4, 5, and 6. The compounds are depicted below:

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13. Claims 3, 6, 17, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The Information Disclosure Statements filed September 23, 2004 and January 4, 2005 have been considered.


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.

16. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zinna Northington Davis
Primary Examiner
Art Unit 1625

Znd
11.09.2006